



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/117,363	09/03/93	COOK P	ISIS1169

HM31/0402

JOSEPH LUCCI  
WOODCOCK, WASHBURN, KURTZ,  
MACKIEWICZ & NORRIS  
ONE LIBERTY PLACE - 46TH FLOOR  
PHILADELPHIA PA 19103

EXAMINER
HOUTTEMAN, S

ART UNIT	PAPER NUMBER
1634	

DATE MAILED: 04/02/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Advisory Action**

Application No.

08/117,363

Applicant(s)

Cook et al.

Examiner

Scott W. Houtteman

Group Art Unit

1634



## THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☐ expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Mar 9, 1998 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☐ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
  - ☐ will not be entered because:
    - ☐ they raise new issues that would require further consideration and/or search. (See note below).
    - ☐ they raise the issue of new matter. (See note below).
    - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
    - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

- ☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
(see attached)
- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):
- Claims allowed: none
- Claims objected to: none
- Claims rejected: 1-29

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

- ☒ Other *The petition to correct inventorship, filed 1/12/98, has been GRANTED. The new inventor, Charles J. Guinosso, will be added to the file label immediately following the mailing of this advisory action.*

**SCOTT W. HOUTTEMAN**  
PRIMARY EXAMINER

The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance.

Applicant argues that one of the references, Urdea, is no longer relevant and that it should be removed and further, because of this removal, a new ground for rejection is required along with reopening prosecution.

This argument is not persuasive. The Urdea reference is still a part of the rejection. Rather than disregarding Urdea, the rejection was simply reviewed using this other interpretation of Urdea. As stated previously, it was assumed, for argument's sake, that Urdea teaches only what applicant suggests; namely, that a protecting group is present at the 5' position, rather than an amino group. The conclusion is that the rejection is still valid. Urdea's teaching have not been disregarded but rather Urdea was simply viewed from applicants perspective.

It is important to take into account the claim which is being rejected. The claim is not limited to embodiments using the 5' position, but broadly reads on 5', 3' and 2' positions. As stated previously, it is Latham, not Urdea, which teaches attachment at the 2' position of the sugar. The argument does not address this portion of the rejection but is based solely on the 5' attachment. Thus, the argument tacitly assumes limitations which are not in the claims.

Applicant argues that there is no demonstration "that this structure [-O-C-N] -- in which the C and N atoms have undefined valency -- would actually be within the scope of any pending claims. This argument is not persuasive. There is no suggestion to construct a rejection having "C and N atoms of undefined valency." The rejection uses prior art that suggests the backbone of the claimed linkages, the valencies depend on which particular side groups are desired. It is

important to note that the claims recite a myriad of possible attachments to the O-C-N backbone. Each attachment results in a different "valence" for the "C" and "N" atoms. The rejection merely reflects this claimed feature.

Applicants argues that there is no motivation. This argument is not persuasive. All of the prior art relates to products and methods for linking labels and other moieties to nucleic acid molecule. The ordinary artisan, in constructing a modified nucleic acid molecule, is motivated to use any prior art knowledge relative to linking moieties to this type of molecule. Furthermore the ordinary artisan would reasonably expect any combination of linking moieties to function equally well.

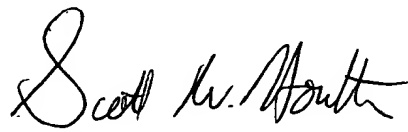
Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 1600 Fax numbers are (703) 305-3014 and 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Houtteman whose telephone number is (703) 308-3885. The examiner can normally be reached on Tuesday-Friday from 8:30 AM - 5:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0196.

Scott Houtteman  
April 1, 1998

  
**SCOTT W. HOUTTEMAN**  
**PRIMARY EXAMINER**